

## **REMARKS**

The Applicant has canceled claims 1-20 and replaced them with a new set of claims which Applicant believes more accurately define the invention. Applicant believes that support for the new claims is adequately found in the Specification and Drawings and that no new matter has been added.

The Examiner has rejected claims 12 and 14 under 35 USC § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Inasmuch as claims 12 and 14 have been canceled, Applicant believes that this rejection has been successfully obviated.

The Examiner next rejects Applicant's claims 1-4, 6-16 and 18 as being rejected under 35 USC § 102(b) as being anticipated by Vernon (US 4,373,562). The Examiner indicates that the device of Vernon reads on the structural limitations of the claims including a bottom plate 24, a back plate 18, a front plate 22, an alignment member 30, 28 and 62, a guide board 64, an alignment aperture through back plate having a fastener 74-76 and a block 70. Additionally, the Examiner indicates that there is a groove engagement section and route engagement section, an adaptor 16 and at least one board. Applicant has canceled the above-referenced rejected claims and replaced them with new claims 21-40. Inasmuch as claims 1-4, 6-16 and 18 have been canceled, Applicant believes that this rejection has been successfully obviated. Applicant respectfully believes that the new claims are in condition for allowance over the cited reference for the following reasons.

The Examiner has indicated that the bottom plate having numeral 24 on the drawings corresponds to the bottom plate of the present invention. Applicant respectfully disagrees as numeral 24 on the cited reference relates to a connecting slot and therefore does not relate to a bottom plate. Similarly, the Examiner has indicated that back plate 18 is similar to the back plate of the present invention. When closely reviewing the '562 reference, numeral 18 refers to the jig itself, in other words the numeral 18 refers to the entire product rather than a specific portion thereof. Similarly, the Examiner has indicated that front plate 22 is similar

to the front plate of the present invention. In fact, front plate 22 refers to the individual slots through which the router may pass in order to create dove tail slots formed in a specific work piece. Even if the Examiner were to look at Vernon and believe that numeral 20, which refers to the template is similar to the Applicant's bottom plate, Applicant would respectfully disagree. Plate 20 is the topmost plate of the unit and when compared to Applicant's claim 21, we can see that the rear plate and bottom plate extends orthogonally away from the bottom plate and define a trough adapted to receive a work piece therein. Inasmuch as the Applicant believes there is no rear plate in the '562 reference, it by definition cannot extend orthogonally away from the bottom plate and also cannot define a trough adapted to receive a work piece as is the case in the present invention.

Still referring to the '562 reference, the Examiner has indicated that the reference includes an alignment aperture through the back plate having a fastener 74 and 76 and a block 70. Referring specifically to Figs. 5 and 7, it can be seen that fastener 74 and 76 as well as block 70 relate to a separate jig attached to the first unit for cutting dove tails. In this unit, fastener 74 and 76 and block 70 assist in the creation of the tapered spline which would pass through the dove tail cut on the first part of the Vernon device. In fact, fastener 74 and 76 and block 70 would not at all assist in aligning a work piece with a plurality of grooves formed in the original template shown in Vernon. Applicant's claim 21 more specifically defines over Vernon by indicating that the alignment member is carried on one of the rear and bottom plates and is adapted to align the work piece with the plurality of grooves. As can be seen from Figs. 5 and 7 of the Vernon reference, it does not at all cooperate with the template grooves 24 and 22. In fact, it is used for an entirely different purpose to cut a separate piece of wood associated with the dove tail process.

Still further, we note that Vernon actually teaches away from the present invention inasmuch as the present invention cuts box joints, and the Vernon reference relates to the formation of corner dove tails with the inclusion of a spline acting as a locking mechanism between the respective dove tail joints. For this reason, Vernon must provide a second jig such as that which utilizes the alignment

mechanism described by the Examiner in order to create a separate spline to extend into the dove tail. Applicant's invention provides no such mechanism.

According to Row v. Dror, 42 USPQ 2d 1550, 1553 (Fed. Cir. 1997) (quoting Kloster Speedsteel AB v. Crucible, Inc., 230 USPQ 81, 84 (Fed. Cir. 1986)) A prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim. . . . "[A]bsence from the reference of any claimed element negates anticipation."

Inasmuch as Vernon does not disclose a rear plate joined to a bottom plate and extending orthogonally away therefrom to define a trough for receiving a work piece or an alignment mechanism carried by one of the rear and bottom plates adapted to align a work piece with a plurality of grooves, it is our opinion that the cited reference does not anticipate Applicant's invention. This position is enhanced by the fact that the cited reference teaches away from Applicant's invention and that it provides for the formation of a dove tail joint rather than a box joint.

The Examiner has also cited the above referenced stating that it is obvious to utilize the reference to create Applicant's invention. Applicant thus far has considered the comparisons made between the Applicant's invention and the cited reference, and it is believed that many of the comparisons between the art and Applicant's invention has been further explained to overcome the Examiner's belief that these general similarities exist. Applicant respectfully submits that new claims 21-40 are neither anticipated nor obvious in light of Vernon and are allowable.

The Examiner rejected claims 5, 14, 15 and 17 under 35 USC 103(a) as being unpatentable over Vernon (US 4,373,562). Inasmuch as these claims have been canceled, Applicant believes this rejection has been successfully obviated.

However, in establishing a prima facie case of obviousness under 35 USC 103, it is incumbent upon the Examiner to provide a reason why one having ordinary skill in the art would have been led to modify a prior art reference to arrive at the claimed invention. The requisite motivation must stem from some teaching, suggestion or interest in the prior art as a whole or from knowledge generally available to one having ordinary skill in the art. See Uniroyal, Inc. v. Rudkin Riley,

Corp., 837 Fed. 2nd 1044, 5 USPQ 2nd 1434 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resin And Refractories, Inc., 776 F. 2nd 281, 227 USPQ 657 (Fed. Cir. 1985).

Where claimed subject matter has been rejected as obvious in view of a prior art reference, a proper analysis under Section 103 requires consideration of two factors; (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composite or device or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out the invention those of ordinary skill would have a reasonable expectation of success. See In Re Dow Chemical Company 837 Fed. 2nd 469, 473, 5 USPQ 2nd 1529, 1531 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure.

It is applicant's position that such suggestion and/or reasonable expectation of success could not be found in the cited reference. Inasmuch as the cited reference does not disclose a jig having a rear plate joined to the bottom plate and extending orthogonally away therefrom, whereby the rear plate and the bottom plate define a trough for receiving a work piece therein, or an alignment member carried by one of the rear and bottom plates adapted to align a work piece with a plurality of grooves, it is Applicant's contention that the cited reference does not anticipate or make obvious Applicant's invention.

The Patent and Trademark Office Board of Patent Appeal and Interferences stated the following in ex parte Clapp, 227 USPQ 972 (1985), at page 973:

"Presuming arguendo that the references show the elements or concepts urged by the Examiner, the Examiner has presented no line of reasoning, and we know of none, as to why the artist when viewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the Examiner has done little more than cite references to show that one or more elements or some combinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to the combination of elements. That is to say,

applicant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion of the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination where the Examiner must present a convincing line of reasoning as to why the artist would have found the claimed invention to have been obvious in light of the teaching of the references."

With the above directives, consideration must be given as to whether the reference in the manner set forth in the Office Action is proper to render the applicant's invention obvious in view thereof.

As set forth hereinabove, it is applicant's contention that the reference does not suggest, nor does it teach the combination as set forth in newly added Claim 21, as is evident from the plurality of differences between applicant's invention and the cited art set forth hereinabove. Again, the reference must teach the alleged combination to render applicant's invention obvious under 35 USC 103. The CAFC, in the recent case of in re Fine, 5 USPQ 2nd 1596, (1988) stated beginning at page 1599 that:

"Obviousness is tested by what the combined teaching of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F. 2nd 413, 425, 208 USPQ 71, 881 (CCPA 1981). "But it cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hospital Sys., 732 F.2nd at 1577, 221 USPQ at 933. "Teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.* Here, the prior art contains none.


As such, it is Applicant's contention that the new claims 21-40 are neither anticipated nor suggested by the prior art reference. Inasmuch as the cited reference does not disclose a number of the features of Applicant's primary independent claim 21.

In view of the foregoing, the Applicant respectfully requests reconsideration of the claims and most earnestly solicits the issuance of a formal notice of

allowability for the claims. Please call the undersigned attorney if any questions remain after this amendment.

Respectfully submitted at Canton, Ohio this 20<sup>th</sup> day of March, 2006.

SAND & SEBOLT

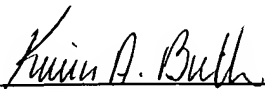
  
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